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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,955	07/24/2003	David O. Lewis	ROC920030175US1	1644
46797 7590 09/21/2007 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER HENEGHAN, MATTHEW E	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/625,955

Applicant(s)

LEWIS ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. In response to the previous office action, claims 1, 9, 20, 31, 46, 47, and 52 have been amended and claims 18 and 19 have been cancelled. Claims 1-17 and 20-53 have been examined.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-17 and 20-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,149,311 to MacKenzie et al. in view of U.S. Patent No. 6,975,204 to Silver et al.

As per claims 1, 8, and 31, MacKenzie discloses the disabling of a key-utilizing resource via an encrypted user disablement command generated from inputted authorization codes issued via a remote server, which is executed after it is verified (authenticated) (see column 6, lines 43-48).

The disablement of MacKenzie's device is effected in software, rather than in hardware.

Silver discloses an analogous system in which an encrypted transmission is sent to a hardware system that disables the system (see column 4, lines 18-31).

Therefore it would have been obvious to one of ordinary skill in the art to use MacKenzie's protocol to disable a hardware system that is in use, such as that disclosed by Silver.

As per claims 9, 10, 17, 36, and 46, an algorithm is disclosed in which a verification is performed by decrypting the command to get a value  $b$ , and also generates a field  $y$ , which it then decrypts to derive a value  $\beta$ . If  $\beta$  does not equal  $\beta$  the disablement operation is aborted by stopping further decryption of it (see column 16, lines 9-38); otherwise, the operation continues.

As per claim 20, 22, and 25-28, the resource is enabled (i.e. unlocked) during initialization via the appropriate codes before disablement (see column 13, line 10 to column 14, line 56).

Regarding claim 38, 41, 42, and 45, the authentication may also include the verification of the transmission of random numbers (see column 10, lines 37-53, which is also incorporated into the disablement protocol).

As per claims 47-51, the device comprises a processor and memory (a plurality of resources) (see column 18, lines 18-31).

As per claims 2, 3, and 39, MacKenzie discloses that use of encryption in verifying the command (see column 17, lines 3-13), based upon the device's unique key information.

As per claims 6, 7, 15, 16, 23, 24, 43, and 44, the device comprises a processor and memory (see column 18, lines 18-31).

Regarding claim 4, 13, and 14, this command may be issued at any time, regardless of whether or not the unit is active/enabled (see column 5, lines 59-67).

As per claims 11 and 19, the b is a function of a key, and is therefore also a key (see column 13, line 11, to column 14, line 12).

As per claims 12, 29, 34, 35, 37, 40, and 53, the decryption requires the private key and therefore can only be done on the non-user accessible chip (the smart chip) having the key.

As per claim 21, enablement and disablement are both achieved using the same algorithm (e.g. ElGamal).

Regarding claim 30, encryption for validation is done at the server.

Regarding claim 32, MacKenzie does not disclose the selling of the device to the user.

Official notice is given that it is well-known in the art to sell end-user devices to potential users, in order to turn a profit.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the devices of MacKenzie to users, in order to turn a profit.

Regarding claim 33, the end user device has an authentication code generator for initialization.

As per claim 52, the user can enable the device by typing and password and can also input a disablement code (see column 6, lines 34-55).

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Matthew Heneghan/

September 17, 2007

Patent Examiner (FSA), USPTO Art Unit 2134